

REMARKS

The claims have not been amended. Accordingly, claims 1-2, 4-14, and 18-26 are currently pending in the application, of which claims 1, 8, 11 and 18 are independent claims.

In view of the following Remarks, Applicant respectfully requests reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Rejections Under 35 U.S.C. § 112, first paragraph

Claims 1-2, 4-14, and 18-26 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Specifically, the examiner asserts that the phrase “real-time notification” was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection for at least the following reasons.

“The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” MPEP, Chapter 2163.02. Applicant acknowledges that the term “real-time notification” (RTN) was not used in the specification, but respectfully submits that the subject matter of RTN is fully supported by the specification as filed. Support for RTN may be found at least at the following locations in the specification:

1. Page 13, lines 16-20: “[i]f the incoming message is a call, the incoming message alarming information may include the identification ... of the calling mobile communication terminal 10 and the information indicating the incoming call's arrival.” (emphasis added)

2. Page 16, lines 3-6: the "incoming message alarming information [indicates] that the called mobile communication terminal 90 is being called or a short message is arriving." (emphasis added)
3. Page 19, lines 20-22: "it is made possible to readily recognize the incoming message's arrival at the mobile communication terminal." (emphasis added)
4. Figure 2: an incoming message recites "YOU ARE BEING CALLED BY 000-000-0000." (emphasis added)

These cited portions of the specification support at least that the sending of a notification message occurs at substantially the same time that a mobile terminal is being called. Individually and collectively, these cited portions of the specification, together with the remainder of the specification, "reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention." Thus, the use of RTN in the claims is supported by the specification in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph.

Further, claim 20 stands rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. Specifically, the examiner asserts that the phrase "if a called subscriber has logged in to an incoming messenger alarming service on the personal computer" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection for at least the following reasons.

Support for this phrase may be found at least at the following locations in the specification:

1. Page 13, lines 8-15: "it is checked whether or not the called subscriber has logged in the messenger service, by using the messenger ID. Then, when the called subscriber has logged in the messenger service, incoming message alarming information indicating the incoming message's arrival is transmitted to the personal computer 80 which the called subscriber has logged in over the Internet 70 by using the searched IP address." (emphasis added)
2. Page 15, lines 7-10: "the incoming message alarming information indicating the incoming message's arrival is transmitted over the Internet 70 to the personal computer 80 which the called subscriber has logged in." (emphasis added)
3. Figure 4; Page 17, lines 21-23: "Then, it is checked whether or not the called subscriber has logged in the messenger service through the personal computer 80 by using the searched messenger ID (S43)."

These cited portions of the specification support at least "if a called subscriber has logged in to an incoming messenger alarming service on the personal computer." Individually and collectively, these cited portions of the specification, together with the remainder of the specification, "reasonably convey to one skilled in the relevant art that the inventor, at the time application was filed, had possession of the claimed invention." Thus, the use of this phrase in claim 20 is supported by the specification in compliance with the written description requirement of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, first paragraph rejection of claims 1-2, 4-14, and 18-26.

Rejections Under 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. See *in re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-2, 4, 8-14, and 18-26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent Application Publication No. 2002/0111167 filed by Nguyen, *et al.* ("Nguyen"), in view of U. S. Patent No. 6,493,431 issued to Troen-Krasnow, *et al.* ("Troen-Krasnow"), and further in view of U.S. Patent Application Publication No. 2002/0042830 applied for by Bose, *et al.* ("Bose"). Applicant respectfully traverses this rejection for at least the following reasons.

"Motivation to modify the references"

The Office Action fails to establish a prima facie case of obviousness because, *inter alia*, the examiner has asserted an insufficient motive to modify the references.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Further, the "references must be viewed without the benefit of impermissible hindsight vision afforded by the

claimed invention.” See MPEP, Chapter 2141. Rather, “the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” See MPEP, Chapter 2142.

Here, the examiner has asserted an insufficient motivation for combining the references by relying on hindsight and the advantages offered by the present invention. Further, the Office Action fails to cogently describe how the references “expressly or impliedly suggest the claimed invention.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Rather, the Office Action, on page 4, summarily concludes that it would have been obvious to combine Nguyen and Troen-Krasnow to “allow[] the called party to receive and retrieve call alarm notifications and messages while logged on to a personal computer.” The basis for such conclusion is to “provid[e] convenience to the user.” Office Action, page 4. Applicant disagrees that this conclusion, which relies entirely upon hindsight and the advantages of the present invention, constitutes “a convincing line of reasoning.”

Further, Nguyen is directed to a system for notifying a called mobile station that an “incoming voice call is waiting” when the mobile station is “operating in a data mode.” Nguyen, Abstract. Thus, the entire purpose of Nguyen is to allow a subscriber to “leave the mode he is in and take the incoming call. He can then go back and finish the ongoing call in the original mode.” Nguyen, paragraph [0006] (emphasis added). To the contrary, Troen-Krasnow is directed to a voice-mail system that permits a user, generally a business, to receive messages from callers when “all telephone lines are busy or a call is not answered.” See Troen-Krasnow, col. 1, lines 42-43; col. 2, lines 30-31 (emphasis added). Because these two references are directed to separate purposes – one to ensure that an incoming call is not missed and the other to provide a message service after an incoming call is missed - a person of ordinary skill in the art at the time of Applicant’s invention would not have been motivated to modify Nguyen’s disclosure with the teachings of Troen-Krasnow to achieve the present invention.

Thus, because the examiner does not provide a “convincing line of reasoning” to suggest the combination of the cited references, the examiner’s purported motivation cannot survive.

“All the Claim Limitations”

The Office Action also fails to establish a prima facie case of obviousness because, even assuming *arguendo* that the references may be combined and a reasonable expectation of success exists, the combined references fail to disclose or suggest all of the claim limitations.

Claims 1-2, 4, 8-14, and 18-26

Specifically, Applicant respectfully submits that the cited references, either alone or in combination, fail to disclose or suggest all claim limitations of independent claims 1, 8, 11, and 18 and all the claims that depend therefrom because, *inter alia*, the examiner has failed to evaluate the claims as a whole. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP, Chapter 2141.02.I (citing to Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)). Rather, the examiner has broken the claims into discrete parts and examined the discrete parts in isolation.

In Schenck, the examiner found the invention, which comprised a vibratory testing machine formed as a continuous integrated device, obvious in view of the combination of four bolted pieces. This conclusion, the court held, improperly limited the focus of the invention to a structural difference from the prior art and failed to consider the invention as a whole. See MPEP, Chapter 2142.02.I.

Similarly, here, the examiner has examined discrete elements of the present invention as recited in claims 1, 8, 11, and 18 in isolation without considering the invention as a whole. As explained above, Nguyen and Troen-Krasnow are directed to separate purposes – one to ensure that an incoming call is not missed and the other to provide a message service after an incoming call is missed. In rejecting the present claims, the examiner has failed to consider how these separate purposes could be combined into a single system that would render the present invention obvious when considered as a whole.

As in Schenck, the present rejections cannot be maintained where the examiner has failed to consider the present invention as a whole.

Claim 11

Applicant also respectfully submits that the cited references fail to disclose or suggest all claim limitations of claim 11. Claim 11 recites, *inter alia*,

a messenger information database for storing an IP address and a messenger ID of a called subscriber; and

a messenger server for sending a second notification message to a personal computer corresponding to the IP address,

Troen-Krasnow, either alone or in combination with Nguyen and Bose, fails to disclose at least these features. The examiner looks to Troen-Krasnow to disclose “a messenger information database for storing an IP address ... of a called subscriber” and “a personal computer corresponding to the IP address.” See Office Action, page 6. Specifically, the examiner asserts that since Troen-Krasnow discloses sending a message to a personal computer, “it is inherent that IP address of the called party is found and used so that the notification message is sent to the called party’s computer.” Id. Further, using this inherency

argument as a springboard, the examiner asserts that "it is inherent that messenger information database exists for storing IP address." Id. Applicant disagrees.

In relying upon inherent features of Troen-Krasnow's disclosure to disclose the features of claim 11, the examiner has failed to offer the necessary support in favor of his position. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP § 2112.IV (citing to Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)) (emphasis in original). Moreover, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112.IV (citing to In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)).

Applicant disagrees that an IP address of a personal computer and a messenger information database are inherently disclosed in Troen-Krasnow. Troen-Krasnow discloses that the "notification message ... may be an electronic mail (email) message transmitted to the called party's personal computer over a computer network." Troen-Krasnow, col. 5, lines 3-5. Contrary to the examiner's assertion, this disclosure does not inherently disclose a "personal computer corresponding to the IP address." Rather, an email message may be transmitted to a server accessible over a network and having an IP address that does not correspond to an IP address of the called party's personal computer. Further to this point, and consistent with Troen-Krasnow, the called party's telephone number may correlate to an email address rather than an IP address.

Thus, for at least these reasons, the above-recited features of claim 11 are not inherent in Troen-Krasnow because they do not "necessarily flow" from Troen-Krasnow's disclosure of transmitting an "electronic mail (email) message ... to the called party's personal computer."

Accordingly, Troen-Krasnow, either alone or in combination with Nguyen and Bose, fails to disclose "a messenger information database for storing an IP address ... of a called subscriber" and "sending a second notification message to a personal computer corresponding to the IP address."

Claim 18

Applicant also respectfully submits that the cited references fail to disclose or suggest all claim limitations of claim 18. Claim 18 recites, *inter alia*,

determining an IP address corresponding to the
identification of the called mobile communication terminal; and
providing real-time notification of the incoming message to
a personal computer corresponding to the IP address.

For at least the reasons asserted above with respect to claim 11, the disclosure of "an IP address corresponding to the identification of the called mobile communication terminal" and "a personal computer corresponding to the IP address" are not inherent in the disclosure of Troen-Krasnow. Specifically, these features are not inherent in Troen-Krasnow because they do not "necessarily flow" from Troen-Krasnow's disclosure of transmitting an "electronic mail (email) message ... to the called party's personal computer."

Since Troen-Krasnow fails to remedy the shortcomings of Nguyen and Bose with respect to claims 11 and 18, the combined references fail to disclose or suggest all features of these claims.

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 8, 11 and 18. Claims 2, 4, 6, 9-14, and 19-24 depend from these independent claims and are allowable at least for this reason. Thus, Applicant respectfully submits that independent claims 1, 8, 11 and 18, and all the claims that depend therefrom, are allowable.

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Nguyen in view of Troen-Krasnow and Bose, and further in view of U.S. Patent Application Publication No. 2005/0097142 filed by Best, *et al.* ("Best"). Applicant respectfully traverses this rejection for at least the following reasons.

Applicant asserts that Best is disqualified as a reference under § 102(e). Best is a U.S. Patent Application Publication and is available under 35 U.S.C. § 102(e) as of its effective U.S. filing date, October 30, 2003. See MPEP § 2136.01(I) & MPEP § 706.02(V)(C). The present Application properly claims priority to and the benefit of Korean Application No. 2003-0065175, filed on September 19, 2003, and thus establishes a date of invention that is earlier than Best's effective U.S. filing date.

In accordance with 37 CFR § 1.55(a)(1), Applicant timely filed a claim of priority to Korean Application No. 2003-0065175 on February 27, 2004. To disqualify Best as a valid reference under 35 U.S.C. § 102(e), Applicant now timely submits a certified copy of Korean Application No. 2003-0065175, an English translation thereof, and a statement that the translation of the certified foreign priority document is accurate in accordance with 37 CFR § 1.55(a)(4)(ii).

Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 5-7. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of claims 5-7, Applicant respectfully submits that these claims are allowable.

CONCLUSION

Applicant believes that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicant respectfully submits that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

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